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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,861	03/31/2004	Edward Vaquero	P03505	5583
23702 7590 07/21/2009 Bausch & Lomb Incorporated One Bausch & Lomb Place Rochester, NY 14604-2701				
EXAMINER				
NGUYEN, TUAN VAN				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
07/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/813,861

**Applicant(s)**

VAQUERO, EDWARD

**Examiner**

TUAN V. NGUYEN

**Art Unit**

3731

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-15 and 18-30 is/are pending in the application.
- 4a) Of the above claim(s) 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15, 18-23, and 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/29/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In previous Office action, claims 13-15, 18-24 and 25-30 are pending and claims 13-15, 18-23 and 25-30 were examined and rejected.
2. This Office action is in response to the RCE filed on 4/29/2009.

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/29/2009 has been entered.

***Claim Objections***

4. Claims 25 and 25 are being objected to because of the following informalities: claim numbering being duplicated. Appropriate correction is required.
5. Claims 25, 25-30 are being objected to because of the following informalities: claims 25, 25, 26 and 28-30 recite the limitation of "the ejector of claim 1". noting that claim 1 has been canceled. Appropriate correction is required. Examiner understood that applicant intended to recite "the ejector of claim 13" and will be

considered as such for the examination purpose. Claim 27 is also objected to because it dependent from claim 26.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

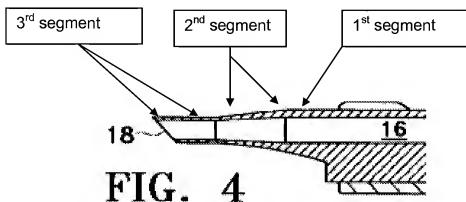
7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 13-15, 18-23, 25, 26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al (U.S. 6491697) in view of Brown et al (U.S. 6010510).**
9. Regarding claims 13, 15, 18-23, 25, 28, 29 and 30, Clark discloses (Fig. 1) an injector body 22 having a first segment 103; a cannula 28, wherein the cannula includes a tip 105 or third segment, and wherein the tip having a constant

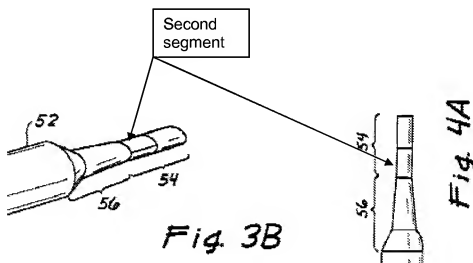
diameter; two slots 121 disposed at the distal region of the tip, and slanted face 119 located at the distal end of the tip; a lumen 107, which extends through cannula 28, is axially aligned with passage 76 of compressing station 26 or loading bay; a compressor drawer 40 extending from the loading bay 26, wherein the drawer comprises a groove 70 (Fig. 6A-6C), which is aligned with the lumen grooves 68 and 76 (col. 3, lines 50-65; col. 4, lines 55-68; col. 5, lines 58-68; and col. 6, lines 30-50). Clark discloses the invention substantially as claimed except for the cannula 28 further comprises a second segment, wherein the second segment connected to the third segment at the transition point, the transition point characterized by a discrete change in taper. However, Brown et al disclose (Fig. 4, reproduced below this paragraph) and IOL injector comprising, among other things, a tip comprising a third segment having a constant diameter, a second segment having taper located on the outer surface and a taper located on the inner surface of bore 16. Apparently, the advantage is for compressing the IOL to fit through a small tip for easy insertion of the injector into a small incision in the ocular tissue. Therefore, it would have been obvious to one of ordinary skill in the art to modify the cannula 28 of Clark according to the suggestion of Brown et al so that it too would have this advantage. With respect to the limitation of "at least one slot extending from the open end through the second segment and third segment". Noting that Clark et al disclose slots 121 disposed at the distal region of cannula 28, it would have been obvious to one of ordinary skill in the art to optimize the length of slots 121 to extend through the second segment to ensure that the IOL

gradually return to its original shape before it is released into the eye to avoid the complication of injury to the eye or tissue near the implanted site from the energy release by IOL while it is "spring" back from the deformation configuration.



10. Regarding claim 14, Clark et al fail to disclose the specific dimension. However, it is old and well known to make the size of an insertion segment of an IOL injector as claimed in order to obtain the advantage of permitting easy insertion of the injector into the eye. It would have been obvious to so size the Clark et al IOL injector so that it too would have this advantage. Extrinsic evidence, Feingold et al (US 6056757) discloses the size of the incision in the ocular tissue necessary to implant an intraocular lens within the capsule of the eye continues to decrease with the progress of intraocular lens deformation technology (col. 1, lines 62-68).
11. Regarding claims 25 and 26, Brown discloses the first segment is unslotted and the first segment has a different taper than the second segment.

12. **Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark et al in view of Brown et al as applied to claim 13 above and further in view of Ott et al. (US 6,447,520).**
13. The modified device of Clark/Brown discloses the invention substantially as claimed except for the second segment has a constant outer diameter. However, Ott et al discloses (Figs. 3B and 4A) that the tip of an IOL injector includes first portion 56 and a tip 54, wherein tip 54 includes a third segment, a second segment the second segment has a constant outer diameter. Apparently the advantage of the constant outer diameter is to prevent the tip from stretching the incision. It has been held that substitution of one known element for another to obtain predictable results is old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to provide a second segment with a constant diameter.



***Conclusion***

This is a request for continued examination under 37 CFR 1.114. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **TUAN V. NGUYEN** whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./  
Examiner, Art Unit 3731

/Anh Tuan T. Nguyen/  
Supervisory Patent Examiner, Art Unit 3731  
7/20/09